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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/761,703	01/18/2001	Takako Asahi	862.C2089	4719
5514	7590	05/04/2005	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			DIVINE, LUCAS	
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			2624	
DATE MAILED: 05/04/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/761,703

Applicant(s)

ASAHI, TAKAKO

Examiner

Lucas Divine

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

1. Claims 10, 13, and 14 are objected to because of the following informalities: The way the claims are written (specifically '**so as to store a sheet in synchronism with display control of said display control means**') appears to imply that the sheet is being stored in the storage unit at the same time as the user is viewing the operation mode screen. This is not possible because the sheet storage unit could not be storing a sheet before the job has been finished being set. The display control means is used to show the user windows corresponding to the operation modes in order for the user to select options and features for these modes. Therefore, the user has not entered the job for printing/copying/faxing yet at the time of displaying the option windows and the sheet unit could not store a sheet for a job that has not been entered yet.

For the prior art rejections, the limitation '**so as to store a sheet in synchronism with display control of said display control means**' is being interpreted as a sheet is stored corresponding with the mode the user has selected on the display control means.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an

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international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 8 –14 are rejected under 35 U.S.C. 102(b) as being anticipated by Kida et al. (US 5852764) hereafter as Kida.

Regarding claim 8, Kida teaches an image forming apparatus (Fig. 2) which can be connected to a sheet processing apparatus (5) having a plurality of sheet storage units (Fig. 1 trays 53, 59, see also col. 30 line 36),

and has a plurality of operation modes including at least two modes from among a copy mode, an image communication mode, and a printer mode (col. 18 lines 54-56),

wherein said image forming apparatus can discharge a sheet of an image formation job to a sheet storage unit corresponding to an operation mode of the image formation job, from among the plurality of sheet storage units (col. 18 lines 65-67, see also Fig. 8), said apparatus comprising:

operation mode shifting means (Fig. 4 CPU 44 controls the overall operation of the system, including the shifting between modes) for automatically shifting an operation mode of a final image formation job to a specific operation mode from among the plurality of operation modes (col. 37 lines 53-67 teach inputting jobs from an external device, such as printing jobs or fax jobs, these jobs are in their final state ready to be formed, and thus are just waiting for output and are performed before a new job can be input from the user console 6 [cols. 12 and 13 in the discussion of the user interface and inputting jobs], further, as shown in Fig. 18, the system automatically shifts to a certain output mode based on the settings of the job that is to be completed) **before a new job is input** (the final image formation jobs stored in memory are

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performed before a new job can be input from the user console 6 because they have been waiting); and

control means for controlling (Fig. 4, sorter control unit 46 controls the sheet output) **the sheet processing apparatus so as to store a sheet in a sheet storage unit corresponding to the specific operation mode** (col. 19 lines 25-35 teach that the sheet is stored in the output tray according to the operation mode), **in response to the shift of the operation mode by said operation mode shifting means before the new job is input** (the tray in use shifts according to the operation mode as assigned in the display shown in Fig. 8).

Regarding claim 9, which depends from claim 8, Kida teaches **display control means capable of displaying display windows corresponding to the operation modes on a display device independently for the respective operation modes** (touch panel liquid crystal display 6 shown in Figs. 5 and 8 inherently must show windows corresponding to the modes in order for the user to select mode options for each),

wherein when said operation mode shifting means shifts the operation mode, display control is performed to display a display window corresponding to the specific operation mode on the display device in synchronism with the control of the sheet processing apparatus (since the shifting means shifts the mode in claim 8, it is inherent that the display would shift as well because the device itself is shifting modes, not just the sheet apparatus).

Regarding claim 11, the structural elements of apparatus claim 8 performs all of the steps of method claim 11. Claim 11 is therefore rejected for the reasons stated in the rejected claim 8.

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Regarding claim 12, the operation of the program storage medium of claim 12 performs the steps of method claim 11 within a computer readable medium. Therefore, claim 12 is rejected for the reasons stated in the rejection of method claim 11. Kida further teaches the use of a CPU 44 capable of performing the method steps as claimed in claim 12 as well as hard disk 43 to store the necessary program data and steps.

Regarding claim 10, Kida teaches an image forming apparatus (Fig. 2) which can be connected to a sheet processing apparatus (5) having a plurality of sheet storage units (Fig. 1 trays 53, 59, see also col. 30 line 36),

and has a plurality of operation modes including at least two modes from among a copy mode, an image communication mode, and a printer mode (col. 18 lines 54-56),

wherein any one of the plurality of operation modes can be assigned to each of the plurality of sheet storage units (Fig. 24, col. 11 line 58, wherein, user selects which unit 52 to use with a selected mode), said apparatus comprising:

display control means for displaying display windows corresponding to the operation modes on a display device independently for the respective operation modes (the display window 6 inherently displays information corresponding to the selected operation mode in order to provide the user unique options and settings for each; for example, the fax mode has dialing options that would only be displayed for the fax mode); and

control means for, when a display window corresponding to any one of the plurality of operation modes is to be displayed on the display device, controlling a sheet storage unit corresponding to the operation mode of the window to be displayed, so as to store a sheet in

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synchronism with display control of said display control means (Kida teaches that the sheet is stored in a sheet storage unit corresponding with the mode selected [Fig. 8], thus if a user has selected a mode and has viewed the options and selected the options for a job, the storage sheet unit correspondingly must shift to the tray associated with mode of which the user has selected).

Regarding claim 13, the structural elements of apparatus claim 10 performs all of the steps of method claim 13. Claim 13 is therefore rejected for the reasons stated in the rejected claim 10.

Regarding claim 14, the operation of the program storage medium of claim 14 performs the steps of method claim 13 within a computer readable medium. Therefore, claim 14 is rejected for the reasons stated in the rejection of method claim 13. Kida further teaches the use of a CPU 44 capable of performing the method steps as claimed in claim 13 as well as hard disk 43 to store the necessary program data and steps.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, and 3 – 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kida in view of Kawamura et al. (US 5587799) hereafter as Kawamura.

Regarding claim 1, Kida teaches an image forming apparatus (Fig. 2) which can be connected to a sheet processing apparatus (5) having a plurality of sheet storage units (Fig. 1 trays 53, 59, see also col. 30 line 36),

and has a plurality of operation modes including at least two modes from among a copy mode, an image communication mode, and a printer mode (col. 18 lines 54-56, Fig. 8), said apparatus comprising:

control means for (Fig. 4, sorter control unit 46 controls the sheet output), in response to shifting to a predetermined operation mode, controlling the sheet processing apparatus so as to store a sheet in a sheet storage unit corresponding to the predetermined operation mode from among the plurality of sheet storage units (Fig. 8, col. 19 lines 25-35 teach that the sheet is stored in the output tray according to the operation mode).

While Kida teaches an image forming apparatus with operation modes and an initial state (col. 38 line 53), Kida does not specifically teach a **determining of a no-operation state for a predetermined time or shifting the operation mode based on the determining result.**

Kawamura teaches an image forming apparatus with operation modes **determination means for determining whether a no-operation state by an operator continues for a predetermined time** (col. 6 lines 4-5 and 12-13 teaches the determining the if a predetermined time has elapsed since the last user 'key' operation); and

auto-clear operation means for automatically shifting to a predetermined operation mode from among of the plurality of operation modes on the basis of a determination result of said determination means (Kawamura teaches reverting 'nullified' to a default device mode when the device is not operated for a predetermined time; col. 6 lines 1-14).

Kida and Kawamura are combinable because they both teach image forming apparatuses with operation modes, user operation areas, sheet storage units, and photocopy units.

It would have been obvious to one of ordinary skill in the art to shift modes based on the no-operation time determining unit of Kawamura in the mode-shifting device of Kida. The motivation for doing so would have been to automatically place the device in a 'default' or 'normal' mode if there has not been activity for a while, saving the next user time and effort if they (predictably) would want to use the 'normal' mode. This would be advantageous in the system of Kida because Kida teaches that the 'normal' mode of the taught invention is for copying (col. 1 line 14, wherein the normal mode is copying). One can conclude that this 'normal' mode is the mode most used and therefore for it is most likely that a user will use this mode. Further, remote devices generally input fax and print jobs, so at the local machine, the copy function can be assumed as the most used by an operator of the operation means. Adding the determining unit of Kawamura would place the invention of Kida in the 'normal' mode after a certain no-operation time, and thus save the next user time and effort if they (predictably) would want to use the chosen 'normal' mode.

Regarding claim 3, which depends from claim 1, Kida teaches **a user interface including a display device commonly used in the respective modes** (touch panel liquid crystal display 6 shown in Figs. 5 and 8 inherently must show windows corresponding to the modes in order for the user to select mode options for each),

wherein when said auto-clear operation means shifts to the predetermined operation mode, display control is performed to display a display window corresponding to the operation mode on the display device in synchronism with the control of the sheet

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processing apparatus (since the shifting means shifts the mode in claim 1, it is inherent that the display would shift as well because the device itself is shifting modes, not just the sheet apparatus).

Regarding claim 4, which depends from claim 1, the combination further teaches **setting means for selecting a mode to be shifted to by said auto-clear operation** (in order to have a predetermined mode to automatically shift to in claim 1, the mode to be shifted to must have been selected).

Regarding claim 5, which depends from claim 1, Kida further teaches a system **further comprising s setting means for performing setting of assigning any one of the plurality of operation modes to each of the plurality of sheet storage units** (Fig. 8).

Regarding claim 6, the structural elements of apparatus claim 1 perform all of the steps of method claim 6. Claim 6 is therefore rejected for the reasons stated in the rejected claim 1.

Regarding claim 7, the operation of the program storage medium of claim 7 performs the steps of method claim 6 within a computer readable medium. Therefore, claim 7 is rejected for the reasons stated in the rejection of method claim 6. Kida further teaches the use of a CPU 44 capable of performing the method steps as claimed in claim 6 as well as hard disk 43 to store the necessary program data and steps.

Response to Arguments

4. Applicant's arguments with respect to amendment filed 12/23/04 have been fully considered but they are not persuasive.

With regards to applicant's argument on page 15 that **Kawamura et al. fails to disclose or suggest switching among operation modes such as a copy mode, image communication mode, or a printer mode.**

In reply, since Kida teaches switching between modes such as a copy, image communication, and fax modes (Fig. 8), Kawamura is relied upon to as teaching the automatically switching between modes of a printer (col. 6 lines 1-14). Thus, the combination itself teaches automatically switching between modes such as copy, image communication and fax. Further in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

With regards to applicant's argument on page 16 that **Kida et al. cannot disclose or suggest that when a display window corresponding to any one of a plurality of operation modes is to be displayed on a display device, a sheet storage unit, corresponding to the operation mode of the window to be displayed, is controlled to store a sheet.**

In reply, this is new matter in the form of 'storing a sheet in synchronism with display control of display means' wherein a sheet is stored while the user is still viewing the operation mode setting for the job and this new matter is not possible because the sheet storage unit could not be storing a sheet before the job has been finished being set. The display control means is used to show the user windows corresponding to the operation modes in order for the user to select options and features for these modes. Therefore, the user has not entered the job for

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printing/copying/faxing yet at the time of displaying the option windows and the sheet unit could not store a sheet for a job that has not been entered yet.

With regards to arguments directed at Kida et al. (US 5957450).

In reply, these arguments have been considered but are moot in view of the new grounds of rejection.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lucas Divine whose telephone number is 571-272-7432. The examiner can normally be reached on Monday - Friday, 7:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Lucas Divine
Examiner
Art Unit 2624

ljd


KING Y. POON
PRIMARY EXAMINER